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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,524	10/16/2001	Gary H. Knauf	119236.00013	5048

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EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/978,524

Applicant(s)

KNAUF, GARY H.

Examiner

Elena Tsoy

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**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Response to Amendment***

Amendment filed on August 23, 2005 has been entered. Claims 1-21 are pending in the application. Claims 13-21 are withdrawn from consideration as directed to a non-elected invention.

***Specification***

1. Objection to the disclosure because of the informalities has been withdrawn due to amendment.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Rejection of claim 2 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn because the examiner agrees that there is sufficient antecedent basis for the limitation "the polymer film coating" in the claim.

***Terminal Disclaimer***

4. The terminal disclaimer filed on 8/23/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,656,401 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Rejection of claims 1-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, 10, 11, 13, 16, 18-20, 23, 25, 30, 33, 40-43 of U.S. Patent No. 6,656,401 has been withdrawn due to filing a terminal disclaimer.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-4, 6-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Backwell (US 3,620,872) in view of Marrocco, III et al (US 5,646,231) for the reasons of record set forth in paragraph 8 of the Office Action mailed on 2/25/2005.

9. Claims 1, 3-4, 8-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (US 3,840,421) in view of Backwell (US 3,620,872), further in view of Marrocco, III et al (US 5,646,231) for the reasons of record set forth in paragraph 9 of the Office Action mailed on 2/25/2005.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson

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(US 3,840,421) in view of Backwell (US 3,620,872), further in view of Marrocco, III et al (US 5,646,231).

Peterson, Backwell and Marrocco, III et al are applied here for the same reasons as set forth in paragraph 9 of the Office Action mailed on 2/25/2005.

The examiner notes that inadvertent error has occurred: a web 44 is claimed lightweight web NOT a polymer film coating of claim 2. A sheet of protective clear vinyl material 72 applied to the web 44 (See column 4, lines 59-65) is the polymer film coating of claim 2. Peterson further teaches that the protective clear vinyl material 72 is sealed to the web 44 (See column 4, lines 63-65).

Peterson fails to teach that the width of the protective clear vinyl material 72 is wider than the width of the web 44 to be protected, as required by amendment.

However, one of ordinary skill in the art would easily recognize that the protective clear vinyl material 72 should be wider than the width of the web 44 to “**protect**” the edges of the web 44.

Therefore, it would be obvious to one of ordinary skill in the art to use a protective clear vinyl material 72 that is wider than a web 44 with the expectation of providing the desired protection of edges of the web 44.

It is the Examiner’s position that the protective clear vinyl material 72 also would help fixing the web 44 to the carrier in addition to the adhesive, as required by amendment.

11. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Backwell (US 3,620,872) in view of Manocco, III et al (US 5,646,231), further in view of Anderson (US

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4,963,303) for the reasons of record set forth in paragraph 10 of the Office Action mailed on 2/25/2005.

12. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Backwell (US 3,620,872) in view of Marrocco, III et al (US 5,646,231), further in view of Enlow et al (US 6,254,712) for the reasons of record set forth in paragraph 11 of the Office Action mailed on 2/25/2005.

***Response to Arguments***

13. Applicants' arguments filed August 23, 2005 have been fully considered but they are not persuasive.

(A) Applicants disagree that Marrocco, III et al supports the examiner's conclusion that Manocco, III et al teach that laminating preformed films is *functionally equivalent* to coating from melt, solution or latex since Marrocco, III et al is directed to rigid-rod polymers and blending the polymers with thermoplastic polymers to achieve improved strength properties for high performance composite materials. Sec Col. 1, lines 15-25.

The Examiner respectfully disagrees with this argument. Manocco, III et al do teach that laminating preformed films is *functionally equivalent* to coating from melt, solution or latex since Marrocco, III et al teach that the same properties would be achieved whether coating is made from preformed films or from melt, solution or latex. Therefore, one of ordinary skill in the art would have reasonable expectation of success of achieving the *same properties* of the polymeric coating film in Backwell whether coating of a polymeric material in Backwell is formed by extrusion or by laminating preformed films.

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(B) Applicants state that it appears that the Office attempted to equate the protective clear vinyl with the extrusion coating. However, such an interpretation is unsupported by the art of record. That is, Peterson teaches that clear vinyl is used to protect the ink, and therefore, could be adhered to the print as in case of extrusion coating.

The Examiner respectfully disagrees with this argument. First of all, one of ordinary skill in the art knows that adhesion strength of a polymeric coating depends not on the technique used for applying the coating but on the properties of the coating material. Secondly, in contrast to Applicants argument, Peterson expressly teaches that the protective clear vinyl material 72 is sealed (i.e. *adhered*) to the web 44 (See column 4, lines 63-65).

(C) Applicants state that in contrast to Peterson NO adhesive is needed in claimed invention.

The Examiner respectfully disagrees with this argument. The claims do not recite a negative limitation about the adhesive.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy  
Primary Examiner  
Art Unit 1762

ELFNA TSOY  
PRIMARY EXAMINER



October 27, 2005